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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,401	01/22/2004	Ola Olofsson	TPP 31436DIV	3311
7590 10/05/2005			EXAMINER	
STEVENS, DAVIS, MILLER & MOSHER, L.L.P.			SELF, SHELLEY M	
Suite 850			ART UNIT	
1615 L Street, N.W.			PAPER NUMBER	
Washington, DC 20036			3725	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/761,401	OLOFSSON, OLA	
	<b>Examiner</b>	<b>Art Unit</b>	
	Shelley Self	3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 July 2005.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-25 and 27 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 20-25 and 27 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/22/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed on July 22, 2005 has been considered but is ineffective to overcome the prior art reference and an action on the merits follows.

The preliminary amendment filed January 22, 2004 has been considered, accordingly the objection to the Specification with regard to subject headings has been withdrawn.

### ***Information Disclosure Statement***

Applicant's remarks regarding the Information Disclosure Statement documents filed in the parent case, Serial No. 10/058,968 now U.S. Patent No. 6,681,820 are persuasive, accordingly each of the references listed on the PTO Form-1449 filed with the parent application and included in the PTO Form-1449 filed January 22, 2004 have been considered.

### ***Specification***

The disclosure is objected to because of the following informalities:

With regard to the Abstract:

- Line 1, "*longitudinal profiles such and tongue and groove...*" is not clear.

With regard to the specification the following are not clear:

- Pg. 1, line 13, "*particles form the milling isn't*", Examiner suggests --particles from the milling—
- Pg. 1, line 20, "*such and tongue*", Examiner suggests, --such as tongue—

- Pg. 2, line 6, "*used it known*", Examiner suggests, --used it is known—
  - Pg. 9, line 32, "*It for*", Examiner suggest, --It is for—
  - Pg. 9, line 32 to pg. 10, line 1, "*possible to moulding a substantial part...*"
- Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 20-22, 24, 25 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Serino et al. (6,357,197). With regard to claims 20, 24 and 27, Serino discloses a system for forming a surface comprising a plurality of boards, the system comprising: a first board (17) having edges, at least one of the edges comprising a projection tongue (16); and a second board (13) having edges at least one of the edges comprising a depressed groove (20; fig. 4A); wherein at least one of the tongue and groove comprise a milled portion of polymeric material (col. 3, lines 35-50) such that the tongue and groove are shaped to form a joint (fig. 1, 4a). Examiner notes a thermoplastic polymer to be a polymer material.

Further regarding claims 20 and 27 and regarding claim 24, Examiner notes "*wherein at least one of the tongue and groove comprise both a milled and a broached portion*", "*the groove comprises both milled and broached portions*" and "*wherein the polymeric material...formed by*

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*extrusion before being milled*” to be product-by-process limitations. Accordingly, because Serino clearly discloses a (product) first and second boards having a tongue and a groove joint, the process by which the tongue and groove of the boards is formed into a joint (i.e., milled and broached) or extrusion before being milled (clm. 24) is not germane to the patentability of the claimed invention. Additionally, the claimed end resultant product (at least two boards having a tongue and groove joint/connection) does not patentably distinguish over the prior art.

With regard to claim 21, Serino discloses the tongue and groove both to comprise a polymeric material. Examiner notes the adhesive (19) between the tongue and groove to be a polymeric material because it consists of a thermoplastic. Applicant’s disclosure states an admitted prior art that; thermoplastic is a type of polymeric material. Accordingly, because Serino discloses board (17) to be comprised of a thermoplastic material and use of an adhesive (18) that is also a thermoplastic material, Serino anticipates, a tongue and groove comprised of polymeric material.

With regard to claim 22, Serino discloses the tongue (16) to be glued (18) to the board (13).

With regard to claim 25, Serino discloses at least one of the first board and the second board comprises a core, the core being formed from wood fiber (col. 3, lines 14-17, 35-37).

Additionally, claims 20, 21, 23, 25 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Martensson et al. (6,421,970). With regard to claims 20, 23 and 27, Martensson discloses a system for forming a surface comprising a plurality of boards, the system comprising: a first board (7) having edges, at least one of the edges comprising a projection tongue (12); and a second board (6) having edges, at least one of the edges comprising a depressed groove (13);

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wherein at least one of the tongue and the groove comprise a milled polymeric material/thermoplastic/lacquer (col. 2, lines 40-48) such that the tongue and groove are shaped to form a joint (figs. 2-12).

As noted above, with regard to claims 20 and 27 and the Serino prior art reference, Examiner notes “*wherein at least one of the tongue and groove comprise both a milled and a broached portion*”, “*the groove comprises both milled and broached portions*” and “*wherein the polymeric material...formed by extrusion before being milled*” to be product-by-process limitations. Accordingly, because Martensson clearly discloses a (product) first and second boards having a tongue and a groove joint, the process by which the tongue and groove of the boards is formed into a joint (i.e., milled and broached) or extrusion before being milled (clm. 24) is not germane to the patentability of the claimed invention.

With regard to claim 21, Martensson discloses the tongue and groove comprised of a polymeric material.

With regard to claim 25, Martensson discloses the at least one of the first and second board formed of a wood fiberboard (col. 2, lines 40-44).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Serino et al. (6,357,197) in view of Martensson et al. (6,42,970). Serino discloses a thermoplastic polymeric material. Serino discloses not disclose the polymeric material to be selected from a group consisting of lacquer. Martensson teaches in a very similar art a system for forming boards wherein a first and second board are manufactured with a mating tongue and groove joint profile, wherein the tongue and groove are comprised of a polymeric material. Martensson teaches the polymeric material to be selected from a group consisting of thermoplastic and lacquer (col. 2, lines 40-48). Examiner notes a lacquer to be a cellulose coating; Martensson discloses several polymeric materials and specifically states, a cellulose product. Accordingly Martensson teaches selection of various polymeric materials one of which is a thermoplastic or lacquer/cellulose material. Martensson teaches this construction so as to provide a waterproof or water resistant surface for reduced wear to the finished tongue/groove panel (col. 2, lines 43-51). Because the references are from a closely related art and deal with a similar problem (i.e., forming a tongue and groove joint between panels) it would have been obvious at the time of the invention to one having ordinary skill in the art to construct Serino of a material having lacquer or a lacquer coating so as to provide a water proof surface as taught by Martensson for improved durability.

### ***Response to Arguments***

Applicant's arguments, filed July 22, 2005 have been carefully considered and are persuasive. Therefore, the 35 U.S.C. 103(a) rejection(s) with regard to Serino et al. in view of Seabra has been withdrawn. However, upon further consideration, as noted above, a new ground(s) of rejection is made.

*Conclusion*

Due to the new grounds of rejection noted above, this action is made Non-Final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (571) 272-4524. The examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on accessing the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSelf

September 28, 2005